

REMARKS

Applicants have carefully considered the April 19, 2007 Office Action, and the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 31-51 are pending in this application. Claims 36-40 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

In response to the Office Action dated April 19, 2007, no claims have been amended. Entry of the present response is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

A number of claims, presumably, claims 31-35 and 41-51, were rejected under 35 U.S.C. § 102(e) as being anticipated over Auerbach (U.S. Pat. No. 5,924,265, hereinafter "Auerbach"). Applicants respectfully traverse.

Initially, the Examiner is requested to specifically identify which claims were rejected in the statement of the rejection. The initial statement on page 2 includes asterisks where the rejection should have listed the applicable claim numbers. Applicants are assuming all elected claims should be included from the lack of a further rejection. It is noted, however, that the subsequent explanation addresses only claims 32-35, 41-44 and 47-51. So, it is unclear whether or not the Examiner really intended to reject all of the elected claims. Such action by the Examiner violates Applicants' right to procedural due process of law by failing to appropriately apprise Applicants why patentability is denied to the claimed invention. *In re Mullin*, 481 F.2d 1333, 179 USPQ 97 (CCPA 1973).

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of the claimed subject matter, such that the identically claimed subject matter is placed into the possession of one having ordinary skill in the art. Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of the claimed subject matter. That burden has not been discharged. Moreover, there are significant differences between the claimed method of independent claims 31 and 45 and the vacuum deck stopping mechanism disclosed by Auerbach that would preclude the factual determination that Auerbach identically describes the claimed subject matter within the meaning of 35 U.S.C. § 102.

The present claimed subject matter is generally directed to a method for controlling an inserting apparatus over a range of master cycle speeds. As discussed in the Background Art section of the specification, modern mail insertion machines such as an inserting apparatus often include both variable-speed devices and actuator-driven devices. An example of a variable-speed device is a rotary device such as a conveyor or assembly that operates by a rotating drive member such as a shaft. An example of an actuator-driven device is a solenoid-driven vacuum cup or gripper that, due to its reciprocative movement and the means by which it is actuated, extends and retracts at substantially unchanging speeds or over substantially constant time periods. The respective operations of the variable speed devices and the actuator-driven devices must be coordinated or synchronized in order to successfully accomplish the intended objective, such as mail insertions, for any given overall machine cycle speed. If the machine cycle speed is changed, such as to accommodate a change in the size of the mail pieces to be processed, the respective speeds or timing of the variable speed devices and the actuator-driven devices often

must also be changed to correlate with the new machine cycle speed, and synchronization among the various variable speed devices and actuator-driven devices must be maintained.

Variable speed devices can quite easily accommodate a change in machine cycle speed because their operation can be controlled by a rotating shaft and/or variable speed motors. However, the rate of functional movement of actuator-driven devices, such as the extension or retraction of an actuator arm, cannot in most cases be changed to any appreciable degree in response to a change in machine speed. Therefore, in order to maintain synchronization of actuator-driven devices in response to a change in machine speed, the timing of actuator-driven devices, or their angular position relative to the overall machine cycle (measured, for example, in degree increments of a 360-degree cycle), must be reset to a different value.

The disclosed subject matter maintains synchronization by making adjustments to the timing of actuator-driven devices in response to changing cycle speed in a unique, real-time manner. A motion controller or similar means is utilized to execute a control process by which a new activation and/or deactivation time for an actuator-driven device can be calculated in response to a change in machine cycle speed. Uniquely, the frequency at which the motion controller executes its control process depends on the frequency of the machine cycle. That is, if for example the motion controller is programmed to execute its control sequence once every machine cycle, then the faster the machine is turning, the greater the number of times the motion controller performs its calculations.

In the Office action, the Examiner asserted that Auerbach teaches relevant subject matter, possibly with respect to independent claims 31 and 45, at Figs. 1, 2, 4 and 5 by way of control system 14. The Examiner, apparently relying on the doctrine of inherency, asserted that control system 14 controls different stations on an inserting apparatus and that the control system 14

calculates cycles to control different operations by way of different stations. Applicants traverse the Examiner's conclusions.

The ability to make on-the-fly adjustments for activation of an actuator device is reflected in the language of independent claims 31 and 45. Claims 31 and 45 require, in pertinent part, a method for controlling an inserting apparatus over a range of master cycle speeds, including the steps of: (1) performing a first calculation to determine a first cyclical position of the new master cycle at which an actuated device should begin to be activated during every master cycle of operation of the inserting apparatus; and (2) at least once during every master cycle of operation, the actuated device is caused to be activated when the new master cycle reaches or exceeds the calculated first cyclical position.

Applicants respectfully submit that Auerbach fails to provide any express or inherent disclosure as to calculating a position at which an actuator device should be activated during a master cycle of an inserting apparatus (as required in claims 31 and 45), much less that the calculation is preformed in response to changing the master cycle speed (as required in claim 31). Thus, the Examiner did not discharge the initial burden of indicating where such a teaching or suggestion appears in the applied reference. Thus, the Examiner has not established that this limitation is inherently disclosed by Auerbach. In this regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection Based on Inherency; Burden of Proof."

In particular, Auerbach, at col. 3, lines 51-56, discloses a control system 14 of inserter system 10 for the purpose of controlling the processing of documents in the various stations of the mass mailing inserter system. Further, Auerbach, at col. 4, lines 15-20, discloses that inserter system 10 includes control system 14 coupled to each modular component of the inserter system

10, which controls and harmonizes operation of the various modular components. No additional details are disclosed in Auerbach about the operation of control system 14.

It is respectfully submitted that the ability to make on-the-fly adjustments for activation of an actuator device is completely foreign to Auerbach and the Examiner has failed to specifically identify where the reference teaches every limitation of independent claims 31 and 45. Thus, the above argued differences between the claimed method and Auerbach's apparatus undermines the factual determination that Auerbach discloses the method identically corresponding to that recited in independent claims 31 and 45. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection under 35 U.S.C. § 102 for lack of novelty as evidenced by Auerbach is not factually viable and, hence, solicit withdrawal thereof.

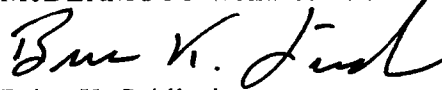
It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

**10/626,595**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck  
Registration No. 51,321

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 BKS:idw  
Facsimile: 202.756.8087  
**Date: July 19, 2007**

**Please recognize our Customer No. 20277  
as our correspondence address.**